REMARKS

Claims 1-4, 29, 30, 32, 33 and 39-41 are pending in the application.

Claims 1-4 and 29 are allowed.

Claims 30, 32, 33 and 39 have been rejected.

Claims 40 and 41 are objected to.

Claims 32, 33 and 40 have been canceled, without prejudice.

Claims 30, 39 and 41 have been amended, as set forth herein.

I. ALLOWABLE SUBJECT MATTER

The allowance of Claims 1-4 and 29, and the indication that Claims 40 and 41 are directed to allowable subject matter, is noted with appreciation. Applicant has included the elements/features of Claim 40 in independent Claim 39, and Applicant has amended Claim 41 to depend from Claim 39.

II. REJECTIONS UNDER 35 U.S.C. § 103

Claim 30 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Focsaneanu (US 5,610,910). Claims 32 and 33 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Focsaneanu (US 5,610,910) in view of Wang (US 6,131,134). Claim 39 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Focsaneanu (US 5,610,910) in view of Wong (US 5,881,103). The rejections are respectfully traversed.

In *ex parte* examination of patent applications, the Patent Office bears the burden of establishing a *prima facie* case of obviousness. MPEP § 2142; *In re Fritch*, 972 F.2d 1260, 1262, 23 U.S.P.Q.2d 1780, 1783 (Fed. Cir. 1992). The initial burden of establishing a *prima facie* basis to deny patentability to a claimed invention is always upon the Patent Office. MPEP § 2142; *In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992); *In re Piasecki*, 745 F.2d 1468, 1472, 223 U.S.P.Q. 785, 788 (Fed. Cir. 1984). Only when a *prima facie* case of obviousness is established does the burden shift to the applicant to produce evidence of nonobviousness. MPEP § 2142; *In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992); *In re Rijckaert*, 9 F.3d 1531, 1532, 28 U.S.P.Q.2d 1955, 1956 (Fed. Cir. 1993). If the Patent Office does not produce a *prima facie* case of unpatentability, then without more the applicant is entitled to grant of a patent. *In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992); *In re Grabiak*, 769 F.2d 729, 733, 226 U.S.P.Q. 870, 873 (Fed. Cir. 1985).

A *prima facie* case of obviousness is established when the teachings of the prior art itself suggest the claimed subject matter to a person of ordinary skill in the art. *In re Bell*, 991 F.2d 781, 783, 26 U.S.P.Q.2d 1529, 1531 (Fed. Cir. 1993). To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed invention and

the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. MPEP § 2142.

With respect to independent Claim 30, the Office Action argues that Focsaneanu discloses each and every element/feature recited in Claim 30, with the exception of the disclosure of user input messages from the telephone that include IP messages received over the IP data network. Office Action, pp. 2-3. However, the Office Action asserts that Foscaneanu indicates the data network may include a packet switched network using protocols (TCP/IP, X.25, ATM, etc.) and it is well-known to include IP messages in user input messages for Internet related application and service. Office Action, page 3.

Applicant has amended Claim 30 to recite that the processor is controlled to:

based on one or more first user input messages from said telephone, launch a first service proxy in response to said one or more first user input messages received from said telephone to establish a voice call between said telephone and a first source, said one or more first user input messages from said telephone including IP messages received over the IP data network; and

based on one or more second user input messages from said telephone received during pendency of said voice call, launch a second service proxy in response to said one or more second input messages received from said telephone based upon information in a configuration data structure to set up at least one non-telephony data service between said telephone and at least one data source, at least where said at least one non-telephony data service does not conflict with said voice call.

As such, Claim 30 has been amended to include element(s)/feature(s) of allowed independent Claim 1. As a result, Focsaneanu fails to disclose, teach or suggest these elements/features recited in Claim 30.

With respect to independent Claim 32 and dependent Claim 33, these claims have been canceled without prejudice.

With respect to independent Claim 39, this claim has been amended to include the elements/features of dependent Claim 40.

Accordingly, the Applicant respectfully requests withdrawal of the § 103 rejections.

III. CONCLUSION

As a result of the foregoing, the Applicant asserts that the remaining Claims in the Application are in condition for allowance, and respectfully requests an early allowance of such Claims.

If any issues arise, or if the Examiner has any suggestions for expediting allowance of this Application, the Applicant respectfully invites the Examiner to contact the undersigned at the telephone number indicated below or at ***rmccutcheon@davismunck.com***.

The Commissioner is hereby authorized to charge any additional fees connected with this communication or credit any overpayment to Davis Munck Deposit Account No. 50-0208.

Respectfully submitted,

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